

### **REMARKS**

This Application has been reviewed carefully in light of the Office Action mailed November 29, 2004 ("*Office Action*"). Claims 1-21 were pending in the Application and stand rejected. Applicant respectfully requests reconsideration and favorable action in this case.

#### **Claim Rejections - Double Patenting**

The Examiner provisionally rejects Claims 1 and 11 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4 of copending U.S. Application No. 09/657,661 in view of U.S. Patent No. 6,370,575, which issued to Dougherty et al. ("*Dougherty*"). Applicant respectfully submits that, if necessary and appropriate, Applicant stands ready to file a terminal disclaimer to overcome any non-provisional double-patenting rejection.

#### **Claim Rejections – 35 U.S.C. § 103**

##### **Claims 1-6, 8-10, 11-16, and 18-21**

The Examiner rejects Claims 1-6, 8-10, 11-16, and 18-21 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,083,277, which issued to Fowlow, et al. ("*Fowlow*"), in view of U.S. Patent No. 6,055,549, which issued to Takano ("*Takano*"), and U.S. Patent No. 6,643,843, which issued to Reger ("*Reger*"). To establish a *prima facie* case of obviousness, the Examiner must satisfy three criteria. First, there must be suggestion or motivation in the prior art to modify or combine the references. Second, there must be a reasonable expectation of success. Third, the modification or combination must teach or suggest all elements of the rejected claims. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Furthermore, the appropriate test under § 103 is whether the claimed invention, *considered as a whole*, would have been obvious or nonobvious. *Jones v. Hardy*, 727 F.2d 1524, 1529, 220 U.S.P.Q. 1021, 1025 (Fed. Cir. 1984).

##### ***Fowlow in View of Takano and Reger Fails to Teach or Suggest All Elements of Claims 1-6, 8-10, 11-16, and 18-21***

Applicant's independent Claim 1 recites:

A method, comprising the steps of:  
providing a set of predetermined function definitions, at least one of said predetermined function definitions defining a function for manipulating image data;  
preparing a project definition, said project definition operable when executed to process said image data and including: a plurality of function portions which each correspond to one of said function definitions in said set, and which each define at least one input port and at least one output port that are functionally related according to the corresponding function definition; a further portion which includes a source portion identifying a data source and defining an output port through which said image data from the data source can be produced, and which includes a destination portion identifying a data destination and defining an input port through which said image data can be supplied to the data destination; and binding information which includes binding portions that each associate a respective said input port with one of said output ports; and  
transmitting through a communications link from a first end thereof to a second end thereof a communication from a user which causes one of storing and execution of the project definition at said second end of the communications link;  
wherein said execution of the project definition operates at least in part to manipulate said image data according to said one predetermined function definition.

Applicant respectfully submits that *Fowlow* in view of *Takano* and *Reger* fails to teach or suggest every element of this claim.

Among other aspects of Claim 1, *Fowlow* in view of *Takano* and *Reger* fails to teach or suggest:

transmitting through a communications link from a first end thereof to a second end thereof a communication from a user which causes one of storing and execution of the project definition at said second end of the communications link;  
wherein said execution of the project definition operates at least in part to manipulate said image data according to said one predetermined function definition.

The Examiner admits that neither *Fowlow* nor *Takano* discloses “a communication from a user which causes one of storing and execution of the project definition at said second end of the communications link.” *Office Action*, page 6. Instead, the Examiner relies upon *Reger* for this element. In general, *Reger* discloses systems and processes for updating program memory of embedded systems such as bill acceptors in vending machines. *Reger*, Abstract and Figure 2. In particular, the Examiner cites the following discussion in *Reger*:

In a download step 56, the portable update probe downloads new program code to the CPU utilizing the optical link. Next, in an update step 58, the CPU updates the contents of the flash memory with the new program code received from the update probe. In step 60, the CPU begins to execute the new program code from the flash memory.

*Reger*, col. 5, lines 50-56. Thus, *Reger* discusses programs stored in flash memory of products with dedicated applications. However, these programs fail to teach or suggest any aspect of the project definition specified in Claim 1. Thus, *Fowlow* in view of *Takano* and *Reger* fails to teach or suggest “a communication from a user which causes one of storing and execution of the project definition at said second end of the communications link.”

Moreover, the programs fail to teach or suggest a project definition whose execution “operates at least in part to manipulate said image data according to said one predetermined function definition.” The Examiner admits that neither *Fowlow* nor *Reger* discloses this aspect of Claim 1. *Office Action*, page 7. To cure the deficiencies of *Fowlow* and *Reger*, however, the Examiner introduces *Takano*. In general, *Takano* discloses processing multiple cells that make up a table, where the cells may include numerical, character, image, or sound data. *Takano*, col. 1, lines 5-67. In particular, the Examiner cites a figure in *Takano* showing a data structure of cell data stored in a table data file. *Takano*, Figure 2, col. 2, lines 5-6, and col. 3, lines 25-44. However, the data structure of cell data stored in a table data file fails to teach or suggest that “execution of the project definition operates at least in part to manipulate said image data according to said one predetermined function definition.” The Examiner also cites discussion in *Takano* regarding requiring a user to input multiple settings into a window before the settings are used to read and edit image data. *Takano*, col. 4, lines 1-33. However, *Takano* discloses that the image file is edited when the settings are input into the window:

When definition items are input in the sub-window for image definition (Step S4), the image data corresponding to the input file name is read from the image file 13 into the processing work memory 6 (Step S5). The read image data is edited in accordance with the definition items of magnification and the rotation input in Step S4 (Step S6).

*Takano*, col. 4, lines 22-27. Thus, *Takano* also fails to teach or suggest that “execution of the project definition operates at least in part to manipulate said image data according to said one predetermined function definition.” Furthermore, *Takano* fails to teach or suggest

transmitting a communication from a user which causes one of storing and execution of the project definition, where execution of the project definition operates at least in part to manipulate the image data according to the predetermined function definition.

For at least these reasons, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of independent Claim 1. For analogous reasons, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of independent Claims 11 and 21. For example, for analogous reasons as those discussed above with regard to Claim 1, *Fowlow* in view of *Takano* and *Reger* fails to teach or suggest the following elements of Claim 11:

transmission of a communication through a communications link from a first end thereof to a second end thereof, said communication causing one of storing and execution of the project definition at said second end of the communications link;

wherein said execution of the project definition operates at least in part to manipulate said image data according to said one predetermined function definition.

Furthermore, for analogous reasons as those discussed above with regard to Claim 1, *Fowlow* in view of *Takano* and *Reger* fails to teach or suggest the following elements of Claim 21:

transmitting through a communications link from a first end thereof to a second end thereof a communication from a user which causes one of storing and execution of the project definition at said second end of the communications link;

wherein said preparing step is carried out at said first end of said communications link, and wherein said transmitting step includes the step of including said project definition within said communication transmitted through said communications link;

wherein said execution of the project definition operates at least in part to manipulate said image data according to said one predetermined function definition.

Claims 2-6 and 8-10 depend from Claim 1, and Claims 12-16 and 18-20 depend from Claim 11. Thus, because these claims depend from independent claims shown above to be allowable over *Fowlow* in view of *Takano* and *Reger*, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of Claims 2-6, 8-10, 12-16, and 18-20.

**The Proposed Combination of Fowlow, Takano, and Reger Is Improper**

Additionally, Applicant submits that there is no teaching, suggestion, or motivation to combine or modify the teachings of *Fowlow*, *Takano*, and *Reger* either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The M.P.E.P. sets forth a strict legal standard for combining or modifying references. According to the M.P.E.P., “[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art” at the time of the invention. M.P.E.P. § 2143.01. “The mere fact that references can be combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination” or modification. *Id.* (emphasis in original).

Governing Federal Circuit case law makes this strict legal standard even clearer. According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation . . . is an ‘essential component of an obviousness holding.’” *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000) (quoting *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998)). While “evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved, . . . [t]he range of sources available . . . does not diminish the requirement for actual evidence.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Indeed, the factual inquiry whether to combine or modify references must be thorough and searching. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52 (Fed. Cir. 2001).

In the present case, the *Office Action* has not cited any evidence of a teaching, suggestion, or motivation to combine or modify the teachings of *Fowlow*, *Takano*, and *Reger*. Instead, the Examiner has merely stated that the teachings of one reference would improve the teachings of another reference. For example, consider the following statement made by the Examiner with regard to the combination of *Fowlow*, *Takano*, and *Reger*:

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine the method of preparing a predetermined set of definitions Fowlow [sic] with

the storing and execution of a program or set of executable definitions at a second end of communication [sic] link as taught by Reger, and further modified by Takano to include manipulation of image data in accordance with the definitions in the file because the automatic storing and execution of code into a remote system would allow the coupling of the Fowlow system to a network for downloading updates, including image data, free of human intervention and without the need for technical expertise as taught by Reger in the Abstract, and the simplification of editing image data as taught by Takano at column 1, lines 54-55.

*Office Action*, page 7. Applicant respectfully submits that the Examiner's statement represents the subjective belief of the Examiner. While the Examiner points to *Reger's* Abstract and two lines of *Takano*, neither of these references, in the cited portions or elsewhere, provides any evidence of a teaching, suggestion, or motivation to combine or modify the references. In particular, each of the cited portions only describes a purported advantage of using the invention described in that reference. However, a purported advantage of using an invention described in one reference does not provide any evidence of a suggestion, teaching, or motivation to combine or modify multiple references. Thus, Applicant respectfully submits that the Examiner has not provided any evidence of a teaching, suggestion, or motivation to combine or modify the references, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

For this additional reason, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of Claims 1-21.

**Office Action Impermissibly Fails to Consider the Claimed Invention as a Whole**

Applicant also respectfully submits that the *Office Action* impermissibly fails to consider the claimed invention as a whole. Instead, the *Office Action* attempts to combine random, unrelated parts of *Fowlow*, *Takano*, and *Reger*. This is improper:

The test under § 103 is not whether an improvement or a use set forth in a patent would have been obvious or nonobvious. The test is whether the claimed invention, considered as a whole, would have been obvious or nonobvious. Failure to consider the claimed invention as a whole is an error of law.

*Jones*, 727 F.2d at 1529, 220 U.S.P.Q. at 1025 (citations omitted). *See also, Hartness Int'l. Inc. v. Simplimatic Eng'g Co.*, 819 F.2d 1100, 1108, 2 U.S.P.Q.2d 1826, 1832 (Fed. Cir. 1987) (“the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed”).

For this additional reason, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of Claims 1-21.

**Fowlow in View of Takano and Reger Fails to Teach or Suggest All Elements of Various Dependent Claims**

Applicant's dependent claims further highlight deficiencies in the cited references. For example, Claim 2 recites “wherein said preparing step is carried out at said first end of said communications link, and wherein said transmitting step includes the step of including said project definition within said communication transmitted through said communications link.” As teaching this element, the Examiner cites Figure 10 and column 18, lines 47-55 of *Fowlow*, which show and discuss a computer system with a central processing unit (CPU) that might be coupled to a telecommunications network using a network connection. *Office Action*, page 8. The Examiner then quotes *Fowlow*: “With such a network connection, it is contemplated that the CPU would receive information from the network, or might output information to the network in the course of performing the above-described method steps.” *Id.* (quoting *Fowlow*, Col. 18, lines 49-53). However, receiving and outputting information to and from a network fails to show “wherein said preparing step is carried out at said first end of said communications link, and wherein said transmitting step includes the step of including said project definition within said communication transmitted through said communications link.”

Furthermore, *Takano* and *Reger* fail to provide this missing element. *Reger* discloses a portable optical probe that a “normal route person” can point to optical transceiver probe ports on vending machines to update program memories of the vending machines. *Reger*, Col. 4, lines 36-41. *Reger* discloses that one advantage of using the portable optical probe is that skilled technicians would not have to be sent to the vending machine with “his computer or replacement ROM in hand.” *Id.* at Col. 4, lines 26-28. Thus, nowhere does *Reger* disclose that “said preparing step is carried out at said first end of said communications link, and

wherein said transmitting step includes the step of including said project definition within said communication transmitted through said communications link.”

As discussed above, *Takano* discloses requiring a user to input multiple settings into a window before the settings are used to read and edit image data. *Takano*, col. 4, lines 1-33. However, *Takano* discloses that the image file is edited when the settings are input into the window:

When definition items are input in the sub-window for image definition (Step S4), the image data corresponding to the input file name is read from the image file 13 into the processing work memory 6 (Step S5). The read image data is edited in accordance with the definition items of magnification and the rotation input in Step S4 (Step S6).

*Takano*, col. 4, lines 22-27. Thus, *Takano* also fails to disclose that “said preparing step is carried out at said first end of said communications link, and wherein said transmitting step includes the step of including said project definition within said communication transmitted through said communications link.”

For analogous reasons, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of Claims 12 and 21.

**Claims 7 and 17**

***Fowlow in View of Takano, Reger, and Madany Fails to Teach or Suggest All Elements of Claims 7 and 17***

The Examiner rejects Claims 7 and 17 under 35 U.S.C. § 103(a) as being unpatentable over *Fowlow* in view of *Takano* and *Reger* and further in view of U.S. Patent No. 6,493,870, which issued to Madany, et al. (“*Madany*”). These Claims depend from Claims 1 and 11 respectively, which are shown above to be patentable over *Fowlow* in view of *Takano* and *Reger*. The introduction of *Madany* fails to provide the elements of Applicant’s Claims 1 and 11 not shown by *Fowlow* in view of *Takano* and *Reger*. Thus, for at least these reasons, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of Claims 7 and 17.



**CONCLUSION**

Applicant has made an earnest attempt to place the Application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of the Application in any manner, the undersigned attorney for Applicant stands ready to conduct such a conference at the convenience of the Examiner.

No fees are believed to be currently due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

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